

Amendment dated September 23, 2004
Reply to Office Action of January 24, 2005

Docket No. 3562-0114P
Appl. No.: 09/826,863
Art Unit: 2615
Page 16 of 25

AMENDMENTS TO THE DRAWINGS

Attached hereto is two (2) sheets of corrected formal drawings that comply with the provisions of 37 C.F.R. § 1.84. The corrected formal drawings incorporate the following drawing changes:

Reference numerals 100, 120, 122, 144 and 146 and the term “audio output section” have been clarified in FIGs. 1 and 2 as requested by the Examiner.

It is respectfully requested that the corrected formal drawings be approved and made a part of the record of the above-identified application.

REMARKS

Applicant appreciates the Examiner's thorough consideration provided in the present application. In addition, as discussed with the Examiner on December 22, 2004 and January 24, 2005, the Examiner has agreed to contact the undersigned via telephone in the Washington, DC area upon entry and consideration of the enclosed Amendment in order to arrange a personal interview to discuss the claim rejections in the present application.

Claims 1-23 are currently pending in the instant application. Claims 1, 13 and 17 have been amended and claims 21-23 have been added. The subject matter of additional claims 21-23 is fully supported by the original written description, including, but not limited to FIGs. 1-3 and the corresponding description in the specification, e.g., pages 14-20 of the specification. Claims 1, 13 and 17 are independent. Reconsideration of the present application is earnestly solicited.

Priority

Applicant appreciates the Examiner's indication of acceptance of the certified copy of the corresponding priority document for the present application.

Amendment dated September 23, 2004
Reply to Office Action of January 24, 2005

Docket No. 3562-0114P
Appl. No.: 09/826,863
Art Unit: 2615
Page 18 of 25

Drawings

Applicant appreciates the Examiner's assistance with respect to the drawings. Without conceding the propriety of the Examiner's objection, but merely to expedite the prosecution of the present application, Applicant has amended FIGs. 1 and 2 to include the amended reference numerals requested by the Examiner. Two (2) sheets of replacement drawings have been provided as an attachment to this Amendment. Accordingly, this objection has been obviated and/or rendered moot.

Specification

Applicant appreciates the Examiner's assistance with respect to the specification of the present application. Without conceding the propriety of the Examiner's objection, but merely to expedite the prosecution of the present application, Applicant has amended the specification as suggested by the Examiner. Accordingly, the Examiner's objections have been obviated and/or rendered moot.

Claim Rejection Under 35 U.S.C. § 103

Claims 1-6, 8, 11, 12, 17 and 20 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tada (U.S. Patent No. 4,746,993) in view of Suzuki et al. (U.S. Patent No. 6,141,043). Claims 7, 9 and 10 have been

rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tada in view of Suzuki et al., and further in view of Cocca (U.S. Patent No. 5,387,955). Claims 13, 15 and 16 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tada in view of Suzuki et al., and further in view of Ohmori (U.S. Patent No. 5,790,193). Claim 14 has been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tada in view of Suzuki et al., and further in view of Ohmori, and further in view of Cocca (U.S. Patent No. 5,387,955). Claims 18 and 19 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tada in view of Suzuki et al., and further in view of Cocca and Ohmori. These rejections are respectfully traversed.

In light of the foregoing amendments to the claims, Applicant respectfully submits that all of the rejections have been obviated and/or rendered moot. Without conceding the propriety of the Examiner's rejection, but merely to expedite the prosecution of the present application, Applicant has amended claims 1, 13 and 17 to clarify the claimed invention for the benefit of the Examiner. Specifically, Applicant submits that the prior art of record fails to teach or suggest each and every limitation of the unique combination of limitations of the claimed invention. Accordingly, this rejection should be withdrawn.

With respect to the Examiner's rejections of claims 1 and 17, Applicant submits that the alleged combination of the prior art of record would not have

been obvious to one of ordinary skill in the art. In addition, Applicant submits that the combination advanced by the Examiner fails to teach or suggest each and every limitation of the unique combination of limitations of the claimed invention.

With respect to claim 1, the prior art of record fails to teach or suggest the combination of limitations of the claimed invention, including the feature(s) of a: “portable multi-function apparatus *having a camera operation mode and an audio operation mode with which at least a music data is operated*, the apparatus comprising. . .*a controller operatively connectable with said image capturing section and said music audio data playing section*, said controller comprising at least one common operation member operable to perform a first function in the camera operation mode and a second function, different from said first function, in the audio operation mode.” (Emphasis Added) Accordingly, this rejection should be withdrawn.

With respect to claim 17, the prior art of record fails to teach or suggest the combination of limitations of the claimed invention, including the feature(s) of a: “controller for operatively associating with a portable multi-function apparatus, *which is operable in a camera operation mode and an audio operation mode with which at least a music data is operated*, the controller comprising. . .at least one common operation member operable to *perform a first function of the portable multi-function apparatus in the camera operation mode thereof and a second*

function of the multi-function apparatus, different from said first function, in the audio operation mode thereof.” (Emphasis Added) Accordingly, this rejection should be withdrawn.

The Examiner has suggested that Tada describes a camera operation mode and an audio operation mode. Suzuki et al. has been interpreted by the Examiner to provide a controller comprising at least one common operation member. However, Applicant submits that the present invention includes audio data having music data. In the claimed invention, e.g., as described at pages 18-19 of the specification, the audio data such as sound data is played in the camera operation mode and a music data, e.g., such as MP3 data, is played in the audio operation mode. Accordingly, the user of the claimed invention can also enjoy listening to music from the same apparatus. In contrast, the alleged combination of the prior art of record does not teach or suggest any music data but instead rely upon sound data such as ambient sound. Accordingly, these rejections should be withdrawn.

With respect to the Examiner’s rejection of claims 13, Applicant submits that the alleged combination of the prior art of record would not have been obvious to one of ordinary skill in the art. In addition, Applicant submits that the combination advanced by the Examiner fails to teach or suggest each and every limitation of the unique combination of limitations of the claimed invention.

With respect to claim 13, the prior art of record fails to teach or suggest the combination of limitations of the claimed invention, including the feature(s) of a: “portable multi-function apparatus *operable in a camera operation mode and an audio operation mode with which at least a music data is operated*, the apparatus comprising. . .a controller operatively connectable with *said main body for an audio operation and a camera operation thereof.*” (Emphasis Added) Accordingly, this rejection should be withdrawn.

The Examiner has suggested that Ohmori describes a multi-functional apparatus wherein an attachment mode that comprise an additional memory and may be connected to the multi-function apparatus, so that the invention was made to have added an additional detachable memory to the controller as taught by Ohmori in order to provide more memory space for the user. However, Applicant submits that the Examiner has not identified any motivation in any of the prior art references that would suggest modifying the Tada reference to include an additional detachable memory to the controller. Accordingly, this rejection is improper and should be withdrawn.

Since the controller of the claimed invention includes a detachable second recording medium for an audio mode for listening to music, the user can choose desired music easily by exchanging a memory card without handling the main body of the apparatus. Therefore, even if the alleged combination of the prior art relied upon by the Examiner were obvious, the resulting combination would still

not include a detachable second recording medium for an audio mode for listening to music. Accordingly, this rejection should be withdrawn.

With respect to additional claims 21-23, Applicant submits that the feature of the "camera operation mode and said audio operation mode is selected according to whether said controller is engaged with said main body or not" is not taught or suggested by any of the references relied upon by the Examiner. In the claimed invention of claims 21-23, a user can enjoy the camera operation mode when the controller is engaged with the main body and the user can also enjoy the audio operation mode when the controller is separated from the main body. In each case, the user has only to operate a single controller comprising the common operation member thereby improving the ease of use of the unique apparatus of the claimed invention.

In accordance with the above discussion of the patents relied upon by the Examiner, Applicant respectfully submits that these documents, either in combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application.

As to the dependent claims, Applicant respectfully submits that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

CONCLUSION

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but merely to show the state-of-the-art, no further comments are deemed necessary with respect thereto.

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicant therefore respectfully request that the Examiner reconsider all presently pending rejections and that they be withdrawn.

In the event there are any matters remaining in this application, the Examiner is invited to contact Matthew T. Shanley, Registration No. 47,074 at (703) 205-8000 in the Washington, D.C. area.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicant respectfully petitions for a one (1) month extension of time for filing a response in connection with the present application and the required fee of \$120.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

Amendment dated September 23, 2004
Reply to Office Action of January 24, 2005

Docket No. 3562-0114P
Appl. No.: 09/826,863
Art Unit: 2615
Page 25 of 25

Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

Marc S. Weiner
Reg. No. 32,181
P. O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

MSW/MTS/mlr

Attachment: Two (2) sheets of formal drawings